

**REMARKS**

Claims 1-7 and 13-18 are pending in this application. Claims 1-7 stand rejected. By this Amendment, claim 1 has been amended and claims 13-18 have been added. The amendments made to the claims do not alter the scope of these claims, nor have these amendments been made to define over the prior art. Rather, the amendments to the claims have been made to improve the form thereof. In light of the amendments and remarks set forth below, Applicants respectfully submits that each of the pending claims is in immediate condition for allowance.

The present invention relates to a metal golf club head where the hardness of the metal itself differs at the center from the peripheral portion of the face. Such a golf club head, having different hardness at the center and peripheral portion of the club head, is realized by subjected the face member to a heating process, such as an aging process. This processing increases the hardness of the entire face member prior to a welding process. Subsequently, the hardness of the peripheral portion of the face member, i.e., the welded portion, is reduced by weld heat when the face portion is welded to other golf face members. It should be noted that the ball hitting facing in independent claims 1 and 2 are both made from a single metal.

Paragraph 1 of the Office Action rejects claims 1 and 3 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,319,150 (“Werner”). Applicants respectfully request reconsideration and withdrawal of this rejection.

To anticipate a claim under 35 U.S.C. § 102, the cited reference must disclose every element of the claim, as arranged in the claim, and in sufficient detail to enable one skilled in the art to make and use the anticipated subject matter. See,

PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1349 (Fed. Cir. 1998). A reference that does not expressly disclose all of the elements of a claimed invention cannot anticipate unless all of the undisclosed elements are inherently present in the reference. See, Continental Can Co. USA v. Monsanto Co., 942 F.2d 1264, 1268 (Fed. Cir. 1991).

Among the limitations of independent claim 1 not present in the cited reference is a ball hitting face made of a metal which includes a central portion and a peripheral portion surrounding at least a part of said central portion wherein the hardness of the metal at said peripheral portion is lower than the hardness of the metal at said central portion.

The Werner reference does not disclose that, at the center and the peripheral portion of the face, the hardness of the metal itself differs. The Werner reference merely discloses that, across the ball-hitting face, the thickness of the face varies. The Werner reference does not disclose an aging process to vary the hardness of the material. In fact, no aging process is disclosed in Werner. Thus, the flexure of the material may vary across the face of the club due to varying thicknesses, however, the hardness of the material will be uniform.

The Werner reference describes a technique in which the thickness of the face wall of the central portion is thicker than the peripheral portion of the face and, as a result, the strength of the central portion of the face is increased. However, Werner does not teach anything about the hardness of the material itself that forms the striking face. Werner does not disclose or even suggest that the hardness of the

metal itself differs at the center than the peripheral portion of the face in any property other than the overall thickness of the face. As such, the Werner reference fails to anticipate independent claim 1.

Claims 3, 5, 7, 13-15, and 18 depend from, and contain all the limitations of claim 1. These dependent claims also recite additional limitations which, in combination with the limitations of claim 1, are neither disclosed nor suggested by Werner and are also believed to be directed towards the patentable subject matter. Thus, claims 3, 5, 7, 13-15, and 18 should also be allowed.

Paragraph 2 of the Office Action rejects claims 5 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Werner in view of U.S. Patent No. 5,405,136 (“Hardman”). Applicants respectfully request reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicants.

The Hardman reference was not included to cure the deficiency discussed above to show additional limitations which, even if it were to show, do not cure the

deficiency discussed above. Hardman merely teaches using inserts having varying hardnesses with a high hardness at the center of the face and parts having low hardness on the peripheral portion of the face. Hardman also teaches the use of a wood member having varying thicknesses, a greater thickness at the center and a smaller thickness at the peripheral portion of the face member (as shown in Figure 16). However, Hardman does not teach a metal golf club head wherein the hardness of the metal itself differing at the center portion and the peripheral portion. As such, claims 5 and 7 should be allowed over the cited combination.

Paragraph 3 of the Office Action rejects claims 2 under 35 U.S.C. § 103(a) as being unpatentable over Werner in view of U.S. Patent No. 5,232,224 (“Zeider”). Applicants respectfully request reconsideration and withdrawal of this rejection.

Among the limitations of independent claim 2, not present in the cited reference is a metal golf club head where “the hardness of the metal of said central portion is smaller than the hardness of the metal at said central portion”.

In Zeider, the face member is separately formed from the main body so that the face member can be formed with a different loft angle. However, Zeider fails to disclose that the hardness of the metal itself differs at the central portion than the peripheral portion of the face. As such, the Zeider reference fails to cure the deficiency noted in Werner discussed above. As such, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 4, 6, 16, and 17 depend from, and contain all the limitations of claim 2. These dependent claims also recite additional limitations which, in

combination with the limitations of claim 2, are neither disclosed nor suggested by the cited references and are also believed to be directed towards the patentable subject matter. Thus, claims 4, 6, 16, and 17 should also be allowed.

Applicants have responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

By \_\_\_\_\_  
Ian R. Blum

Registration No.: 42,336  
DICKSTEIN SHAPIRO MORIN &  
OSHINSKY LLP  
1177 Avenue of the Americas  
New York, New York 10036-2714  
(212) 835-1400  
Attorney for Applicant

IRB/mgs